

Endo et al. (U.S. Patent No. 5,123,077; hereinafter "Endo"). The Office Action also rejected Claims 6, 12, and 14-15 under 35 U.S.C. §103(a) as being unpatentable over Kawahara in view of Claim 2 and further in view of Schumacher and McGaffin (U.S. Patent No. 6,031,958; hereinafter "McGaffin"). Applicants respectfully submit that the pending claims are patentable for at least the following reasons.

Applicants' Claim 1 recites: "[a] A side-emitting illumination device for uniformly distributing light comprising: an LED light source, a light-transmitting rod which permits total internal reflection, and outcoupling material affixed to an outer surface of the rod, wherein the width of the outcoupling material affixed to an outer surface of the rod controls the angular distribution of light leaving the side of the rod."

Kawahara fails to recite or suggest the outcoupling material controls the angular distribution of light leaving the side of the rod.

Schumacher cannot be properly combined with Kawahara because it recites a hollow light guide 8 covered on its inner surface with an optical lighting film 10 which is provided with a light extractor 12 made of scattering film 13. (See, e.g., Col. 4, lines 28-49)

One of ordinary skill in the art, therefore, would not be motivated to use this coating for a hollow light guide with an emitting rod of Kawahara. M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Kawahara and Schumacher fail to provide the motivation to combine and reasonable expectation of success. Consequently, Claim 1 is believed patentable over Kawahara in view of Schumacher for at least these reasons.

In addition, the width of extractor 12 recited in Schumacher refers to the thickness of extractor 12 (See, e.g., Fig. 3A), as opposed to width as defined in Applicants' specification as angular width. Consequently, Claim 1 is believed patentable over Kawahara in view of Schumacher for at least the additional reason that the combination of the two references fail to recite or suggest all the limitations of Applicants' Claim 1.

Further, mere possibilities do not constitute grounds by which an obviousness rejection can be maintained without improper

hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). This improper hindsight indicates an improper means by which to reject a claim.

Independent Claim 19 recites a method of controlling the angular distribution of light substantially corresponding to Claim 1 and is believed patentable for at least the same reasons. In addition, as no rejection of Claim 19 is included in the December 4, 2002 Office Action, it is believed allowable.

Claims 2-18 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 2-18 to be independently patentable and request separate consideration of each claim. In addition, Applicants respectfully believe the above amendments and remarks render the § 103 rejections of Claims 2-18 moot. Withdrawal of the § 103 rejections is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned agent may be reached by telephone at the number given below.

Respectfully submitted,

By 
Aaron Waxler,
Reg. 48,027
(914) 333-9608
March 4, 2003

FAX RECEIVED

MAR 4 2003

TECHNOLOGY CENTER 2800